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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/788,869	02/27/2004	Ben Nee Goon	TI-32154	7235
23494 7590 04/04/2007 TEXAS INSTRUMENTS INCORPORATED P O BOX 655474, M/S 3999 DALLAS, TX 75265			EXAMINER MOONEYHAM, JANICE A	
			ART UNIT	PAPER NUMBER
			3629	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/04/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/788,869

Applicant(s)

GOON, BEN NEE

Examiner

Janice A. Mooneyham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to the applicant's communication filed on January 11, 2007, wherein:

Claims 1-20 are currently pending;

Claim 15 has been amended.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anecki et al (US 2006/0010377) (hereinafter referred to as Anecki).

Referring to Claims 1, and 14-17:

Anecki discloses a method, medium and system for processing a legal document over a network connecting a requestor to a plurality of responders, comprising:

a database server comprising a distributed database server comprising one or more servers distributed over one or more networks (Figure 1);

at least one requestor computing system coupled to the database server (Figure 1);

at least one responder computing system coupled to the database server, wherein the waiver request database server (Figure 1) is configured to

providing a legal document database that is **operable** to store a plurality of documents ([0044], Figure 1 (1070) Figure 2 (1130));

receiving at the database a request from the requester (Figure 2 (1100) [0048]);

sending a notification from the database to the plurality of responders (Figure 2 (1160, 1190) [0009]; and

transmitting data from the database to the requestor, whereby the requester **may** determine whether the request has been approved by at least one of the plurality of responders (Figure 2 (1170) (1192), [0007] [0046] [0051] [0053]).

Anecki does not explicitly disclose that the document is a waiver request.

However, Anecki discloses a method for network based document management environment wherein the term "document" is any instrument conveying information.

Thus, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the interactive method of automating the generation of legal documents among multiple requestors and requiring approval of various participants as disclosed in Anecki with the ability to make one of the documents a waiver request since one skilled in the art would recognized a waiver as simply being a legal document providing an express statement, which intentionally and voluntarily gives up something, such as rights, since in many business environments, large numbers of legally binding documents need to be generated, executed, and tracked by participants and many business need to route the documents through a number of different participants and a distributed system as disclosed in Anecki provides for the coordination and generation of the documents.

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As for the language that "the request seeking a waiver of at least one of the specification elements from at least one of the plurality of responders" and the notification "seeking the requested waiver of the at least one specification element", the Examiner deems this language to non-functional descriptive data, not functionally related to the steps of the method. Non-functional descriptive data adds little, if anything, to the claimed acts and thus does not serve as a limitation on the claims to distinguish over the prior art. The providing a database step, the receiving a request at the database, the sending a notification, and the transmission of data from the database would be the same, no matter what language is in the request or the notification (See *In re Gulack*, 703 F. 2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F. 3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

As for the language that the database is *operable* to store data, the applicant is directed to MPEP section 2106 wherein it states that:

C. Review the Claims

The claims define the property rights provided by a patent, and thus require careful scrutiny. The goal of claim analysis is to identify the boundaries of the protection sought by the applicant and to understand how the claims relate to and define what the applicant has indicated is the invention. USPTO personnel must first determine the scope of a claim by thoroughly analyzing the language of the claim before determining if the claim complies with each statutory requirement for patentability. See *In re Hiniker Co.*, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998) ("[T]he name of the game is the claim.").

USPTO personnel should begin claim analysis by identifying and evaluating each claim limitation. For processes, the claim limitations will define steps or acts to be performed. For products, the claim limitations will define discrete physical structures or materials. Product claims are claims that are directed to either machines, manufactures or compositions of matter.

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USPTO personnel are to correlate each claim limitation to all portions of the disclosure that describe the claim limitation. This is to be done in all cases, regardless of whether the claimed invention is defined using means or step plus function language. The correlation step will ensure that USPTO personnel correctly interpret each claim limitation.

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) "adapted to" or "adapted for" clauses,
- (C) "wherein" clauses, or
- (D) "whereby" clauses.

This list of examples is not intended to be exhaustive. See also MPEP § 2111.04.

2111.04 "Adapted to," "Adapted for," "Wherein," and "Whereby" Clauses [R-3] - 2100 Patentability

2111.04 "Adapted to," "Adapted for," "Wherein," and "Whereby" Clauses [R-3]

Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. However, examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are:

- (A) "adapted to" or "adapted for" clauses;
- (B) "wherein" clauses; and
- (C) "whereby" clauses.

The determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case. In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a "'whereby' clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention." *Id.* However, the court noted (quoting *Minton v. Nat'l Ass'n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620

(Fed. Cir. 2003)) that a "whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited." *Id.*

The Examiner interprets the term "operable" as being adapted for. Thus, when applicant claims that a database is operable to store requests, then all that is required is a database fully capable of storing the requests. The Examiner asserts that the database in Anecki is fully capable of storing the claimed data.

As for applicant's limitation in claim 1 which reads "transmitting data from the waiver request database to the requestor, whereby the requestor *may* determine whether the waiver request has been approved", the Examiner asserts that the term "may" is not a positive recitation of a step. Applicant is directed to MPEP 2106 wherein it states:

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.

As for the language in claims 14 and 16 which claims wherein the request is for the waiver of at least one test corresponding to the at least one of the specification elements and wherein the instructions are configured for:

notifying the requestor for additional information;
receiving additional information,
and notifying the plurality of responders about the information
the Examiner asserts the following:

The Examiner deems this language to non-functional descriptive data, not functionally related to the steps of the method. Non-functional descriptive data adds little, if anything, to the claimed acts and thus does not serve as a limitation on the claims to distinguish over the prior art. The providing a database step, the receiving a request at the database, the sending a notification, and the transmission of data from the database would be the same, no matter what language is in the request or the notification (See *In re Gulack*, 703 F. 2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F. 3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Referring to Claims 2-6, and 8:

While Anecki discloses a requestor and a responder and notification being sent (Figure 1), Anecki does not disclose receiving in the request database another request from another requestor, i.e., multiple requests, wherein the database sends another notification to a plurality of responders.

However, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the document

exchange disclosed in Anecki the ability to process multiple requests.

Referring to Claims 7 and 18:

As for claims 7 and 18, the Examiner notes that the claim limitation states that if the at least one response is a request for additional information about the waiver request:

notifying the requestor about the request for additional information; receiving additional information from the requestor; and

notifying the plurality of responders about the additional information.

The Examiner directs the applicant to MPEP 2106 wherein it states:

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.

Referring to Claims 9 and 19:

Anecki discloses wherein the at least one response is selected from the group consisting of: approving the request; rejecting the request; requesting to hold the

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request; and requesting additional information about the request (Figure 2 (1140) [0051]).

Referring to Claim 10:

Anecki discloses generating a database entry corresponding to each request in the request database ([0008] [0084]).

Referring to Claims 11 and 20:

Anecki discloses wherein the request database is a distributed database comprising one or more database servers distributed over one or more networks (Figures 1, 3a-3b, [0037]).

Referring to Claim 12:

Anecki discloses wherein the sending the notification comprises an action selected from the group consisting of: sending an e-mail; sending an instant text message; and sending a prerecorded voice message ([0009], [0037], [0041-0043]).

Referring to Claim 13:

Anecki discloses wherein the sending of the notification is repeated for a certain period of time or until a certain number of responses are received from the plurality of responders (Figure 2, [0009]).

Response to Arguments

Applicant's arguments filed January 11, 2007 have been fully considered but they are not persuasive.

The Examiner directs the applicant to the discussion accompanying the rejection as for the Examiner's position to the applicant's arguments, wherein the Examiner has addressed the each and every argument presented by applicant.

Conclusion

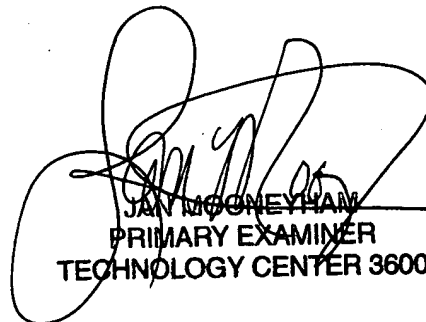
THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



JANICE A. MOONEYHAM
PRIMARY EXAMINER
TECHNOLOGY CENTER 3600